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UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. 05 CV 01114 JW MDL No. 1665 **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S OPPOSITION TO DEFENDANTS' MOTION FOR SUMMARY JUDGMENT OF INVALIDITY AND NONINFRINGEMENT OF ALL CLAIMS OF THE '702 PATENT** Date: June 2, 2006 Time: 9:00 a.m. Ctrm: 8, 4th Floor Judge: Honorable James Ware

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I. INTRODUCTION

Acacia opposes Defendants' motion for summary judgment on the grounds that the issue presented by Defendants' motion is already squarely before the Court in Acacia's pending Motion for Entry of Judgment of Non-Infringement and Invalidity for Indefiniteness of the '702 patent and Certification Pursuant to Fed.R.Civ.P., Rule 54(b). The Court has stated that it would not rule on Acacia's motion until *after* all of the claim terms at issue in the Yurt family of patents have been construed by the Court. Claim construction should be complete by the fall of this year.

Thus, the Court should postpone ruling on defendants' motion until after the Court has completed its claim constructions and at the same time that the Court rules on Acacia's request for certification pursuant to Rule 54(b).

II. THE COURT SHOULD WAIT UNTIL AFTER ALL OF THE CLAIM TERMS IN THE YURT FAMILY OF PATENTS ARE CONSTRUED BEFORE IT DECIDES WHETHER TO GRANT SUMMARY JUDGMENT ON THE '702 PATENT

Acacia's motion for summary judgment, like defendants' motion now, seeks entry of a final judgment that all of the claims of Acacia's '702 patent are: (1) invalid, due to the Court's finding that the claim terms "sequence encoder" and "identification encoder" are indefinite, and (2) not infringed, due to the Court's construction of the phrase "transmission system at a first location" limits all of the claims to transmission systems which are located at one particular location. The only significant difference between Acacia's motion and defendants' present motion is that Acacia also asks that the Court certify the judgment pursuant to Fed.R.Civ.P., Rule 54(b), so that Acacia can immediately appeal the judgment.

Defendants' present motion is *redundant* of their opposition to Acacia's motion for summary judgment. In their opposition to Acacia's motion, defendants asked the Court to enter essentially the same judgment that they seek by this motion. Defendants even filed their own proposed order seeking summary judgment. Defendants' opposition to Acacia's motion was therefore, in effect, a cross-motion for summary judgment, seeking the same judgment that defendants seek now.

At oral argument on February 24, 2006, the Court had the opportunity to enter summary judgment of invalidity and non-infringement of all claims of the '702 patent, but the Court chose *not* to do so. Instead, the Court stated that, because it had not completed construing claim terms from other patents in the Yurt family of patents (including the parent '992 patent) and because the parties' argument and contentions on other terms may persuade the Court to change its prior constructions on the '702 patent, the '702 patent would remain "on the screen." The Court therefore took Acacia's motion under submission until after the Court had completed claim construction on the remaining terms from the asserted Yurt patents:

> I have given you rulings. I'm happy that you find them to be final enough that you're willing to stipulate to a judgment and move the '702 off the screen, but as far as I'm concerned, it remains on the screen until I have gone through at least, at least an examination of, of the parent patent.
>
> '992 is the parent patent. '702 is a divisional patent and the continuation patents I know don't all apply to, to the same defendants here but they all derive from a common specification and so until I, until I have a better opportunity to look at this, my inclination at this point is to not certify it for immediate appeal.
>
> That is not to say that I won't, I won't do so prior to sending cases back to the transferor courts. I just want to have the benefit of, of further consideration of, of some of the claims because what happens is that some of the system claims and the method claims as you are arguing to me in this, in this system configuration, construction, I should, I should define the system by, by looking at the method.
>
> Well, I'm sure I am going to have to look at the method and look at the system at some point that argument may be made to me. So rather than let go now, I think I'll -- my tentative decision is to hold on to everything.

(February 24, 2006 Transcript, at 35:12-37:11).

The Court's decision to wait for claim construction to be completed before entering any judgment on the '702 patent is eminently practical. For example, at the February 24, 2006 hearing, the Court stated that it would not stay the cases involving the New York defendants[1], whose cases had just been transferred by the MDL Panel to this Court. Accordingly, the Court gave the New York defendants the opportunity to address any claim terms from the '992 patent that the Court has already construed. The New York defendants have since indicated that they intend to address nearly every one of the Court's prior constructions of terms in the '992 patent claims, including the term

[1] The New York defendants are Time Warner Cable, Inc. and CSC Holdings, Inc. (Cablevision).

"transmission system," which is part of the '702 patent claim phrase "transmission system at a first location." The fact that the Court will still be considering the construction of the term "transmission system" was one of the Court's concerns and one of the reasons why the Court did not grant summary judgment on the '702 patent on February 24. (See, February 24, 2006 Transcript, at 16:15-22:5).

III. THERE IS NO LEGITIMATE REASON WHY THE COURT MUST DECIDE SUMMARY JUDGMENT ON THE '702 PATENT AT THIS TIME

There is no urgency to defendants' motion and there is no possibility of any prejudice to defendants if the summary judgment issue is not decided until after the Court has completed claim construction. At this time, the parties are preparing their briefing on the additional claim construction issues for the other patents in the Yurt family, including terms from the '992 patent which the Court has already construed. The Court will hear argument on June 9 and August 11, 2006 on all of the remaining claim terms that are at issue. There is no more litigation activity involving the '702 patent at this time, as the parties are not asking the Court to construe any additional claim terms from the '702 patent. Thus, it should be irrelevant to defendants whether summary judgment on the '702 patent is entered on June 2, 2006, or after August 11, 2006, when the Court is expected to complete its construction of the remaining claim terms.

Acacia will, however, be prejudiced if the Court grants defendants' motion for summary judgment on June 2, 2006. Pursuant to Acacia's pending motion for summary judgment on the '702 patent, Acacia is agreeable to summary judgment on the '702 patent, but *only* if the judgment is certified for immediate appeal pursuant to Rule 54(b). The Court, however, has stated that it will not decide summary judgment or Acacia's request for Rule 54(b) certification until after the claim construction on the Yurt family of patents is completed this summer. Therefore, if the Court grants *defendants'* motion on June 2, 2006, it will likely do so without making a final decision on Acacia's request for Rule 54(b) certification. Thus, by filing their motion and seeking a decision on June 2, 2006, before the Court can complete claim construction, defendants are attempting to circumvent Acacia's motion and force the Court to enter judgment on the '702 patent before the Court is able to consider Acacia's request for Rule 54(b) certification. This would be contrary to the Court's

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statements that it wished to consider the remaining claim terms before it issued a judgment on the '702 patent and before it decided the Rule 54(b) issue raised by Acacia.

IV. CONCLUSION

For the foregoing reasons, the Court should postpone ruling on defendants' motion until *after* the Court has completed its constructions by this fall, at which time, the Court will also rule on Acacia's request to certify any judgment on the '702 patent pursuant to Rule 54(b).

DATED: May 12, 2006

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I am employed in the County of Los Angeles, State of California. I am over the age of 18 years and not a party to the within action; my business address is 601 South Figueroa Street, Suite 3300, Los Angeles, California 90017.

On May 12, 2006, I served a copy of the within document described as **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S OPPOSITION TO DEFENDANTS' MOTION FOR SUMMARY JUDGMENT OF INVALIDITY AND NONINFRINGEMENT OF ALL CLAIMS OF THE '702 PATENT** by transmitting via United States District Court for the Central District of California Electronic Case Filing Program the document listed above by uploading the electronic files for each of the above listed document on this date, addressed as set forth on the attached Service List.

The above-described document was also transmitted to the parties indicated below, by Federal Express only.

Chambers of the Honorable James Ware
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3 copies

I am readily familiar with Hennigan, Bennett & Dorman LLP's practice in its Los Angeles office for the collection and processing of federal express with Federal Express.

Executed on May 12, 2006, at Los Angeles, California.

I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made.

/S/ Carol Yuson
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